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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/575,433	12/20/1995	LISHENG HUANG	RIC-95-042	8140

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EXAMINER

TRAN, PHUC H

ART UNIT PAPER NUMBER

2666

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/575,433

Applicant(s)

HUANG, LISHENG

Examiner

PHUC H TRAN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-11,14-17,19,20,22 and 26-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-11,14-17,19,20,22,26-28,31-33 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 29,30 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This Non-Final Rejection is responded to the preliminary amendment was field on 8/28/98.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 4-7, 9-10, 26-31 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said digital packets" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 34 recites the limitation "the unit charge" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

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was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1,4-7,9-11,14-17,19,20,22, 26-28, 31-33, and 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Norris et al. (U.S. Patent No. 5805587).

- With respect to claims 1, 6-7, 11, 16-17, 22, 28, & 31, Norris teaches a telecommunications system (e.g. Fig. 1) comprising: an originating circuit-switch network provides originating signals in response to voice input (e.g. blocks S1 & S2 and block 100 in Fig. 1); an originating gateway computer converts the originating signals into packets of digital data and digital to signal (e.g. block 200 in Fig. 1); a terminating gateway computer, that accepts out of band signaling (col. 3, line 33) and converts a digital packets into terminating signals or terminating signals to the digital packets (col. 7, lines 65-66); a terminating circuit-switched network provides voice output in response to the terminating signals and capable of providing voice input to the terminating gateway computer (e.g. block 100 receives incoming packets from block 200 in Fig. 1); and packet-switched network transmits the digital packets from/to the originating to/from the terminating gateway computer (e.g. block 300 in Fig. 1), at least on of the originating and terminating gateway comprising a component for routing the digital packets through the packet-switched network from the originating to the terminating gateway computer in response to dialed digits, spoken digits (e.g. col. 3, lines 4-7).

- With respect to claims 4-5, 9-10, 14-15, & 19-20, Norris also teaches wherein the terminating gateway computer comprises a buffer for storing the digital packets prior to the

conversion thereof into the terminating signals (block 250 in Fig. 3) and rearranging for a proper packet order (e.g. calls in process in order).

- With respect to claims 26 & 32, Norris discloses wherein at least one of the routing components comprises address resolution logic and a network routing database implemented with a central processing unit (col. 6, lines 36-39).

- With respect to claims 27 & 33, Norris explicitly fails to teach wherein the originating gateway terminal computer includes a component for providing a ring back tone or a busy tone to a telephone connected to the originating circuit-switched network, however, it's well known in the art at the time of the invention was made that a busy tone will be sent to the callers when the callee's line is busy.

- With respect to claims 35-37, Norris further teaches providing a caller's address and callee's address to an originating gateway computer in the originating network (e.g. col. 2, lines 66-67); authorizing a call using the caller's address and the routing (col. 3, lines 4-7); the terminating gateway computer to dial out the callee using the callee's address and the originating gateway computer provide a return tone for advising the callers of a status of the call (e.g. the internet access server using the address to communicate with terminals S1, S2, & DT1).

Allowable Subject Matter

6. Claims 29-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. Claim 34 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims 1,4-7,9-11,14-17,19,20,22, 26-28, 31-33, and 35-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Doshi et al. (U.S. Patent No. 6324179 B1) discloses ATM network arranged to interface with STM in-band signaling.

- Turock (U.S. Patent No. 6243373 B1) discloses method and apparatus for implementing a computer network/internet telephone system.

- Bell et al. (U.S. Patent No. 5659542) discloses system and method for signalling and call processing for private and hybrid communications systems including multimedia systems.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H TRAN whose telephone number is (703) 308-7471. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on (703) 308-5463. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9314.

Phuc Tran
Assistant Examiner
Art Unit 2664

P:t
January 7, 2003


D. J. T. O. N.
PRIMARY EXAMINER